

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAYUKI KONDO

Appeal No. 2005-0564
Application No. 09/732,787

HEARD: MAY 4, 2005

Before KRASS, BARRY and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the Appellant's request for rehearing¹ of our decision mailed May 31, 2005, wherein we affirmed the Examiner's 35 U.S.C. § 103 rejection of claims 4 and 7 over the admitted prior art and Gerrans and of claims 6 and 8 over the admitted prior art, Gerrans and Hauchard.

We have carefully considered the arguments raised by Appellant in the request for rehearing, however, those arguments do not persuade us that our decision was in error in any respect.

¹ Filed on August 1, 2005.

The only argument raised by Appellant is that reliance on a "smoother grip" as the motivation for combining the references is unreasonable (request, page 2). Appellant further points out that nowhere the present application discloses that the admitted prior art in Figure 6 would even be gripped or how it would benefit from a smoother grip (id.). However, we find that Appellant's position improperly limits the motivation or suggestion to one that is explicitly outlined in the applied prior art references. The suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references).

Additionally, Appellant asserts that one of ordinary skill in the art would not have been concerned with the gripping of the terminal because it is not discussed (id.). Appellant apparently overlooks the common use for the claimed terminal structure as a terminal for connecting a wire to an input/output terminal of a

device. Although gripping the wire terminal is not mentioned in the specification and in relation with the admitted prior art, one of ordinary skill in the art would readily recognize that the terminal may be connected by gripping it at least once, even if the connection remains undisturbed afterwards. Moreover, in evaluating the prior art references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Here, we are not convinced that gripping the wire need to be specifically discussed in order to educate the skilled artisan how to use the wire terminal for connecting or whether the wire terminal should be gripped.

Further, as we explained in pages 6-7 of our original decision, the reference teachings and the discussion of the admitted prior art as a whole are the evidence supporting the nature of the subject matter. For example, as shown in Figures 1 and 2 of Gerrans, the soft plastic tail over-mold 16 and 64 covers the connector and part of the wire as it bonds with the insulation 22 and 62 which covers the wire (col. 4, lines 1-3 and 55-60). Therefore, similar to the claimed subject matter as discussed by Appellant (request, page 3), the resulting terminal

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still benefits from the shape of the flexed wire and waterproofing while detachment of the molded portion from the wire is prevented as the soft plastic bonds to the wire.


Therefore, as discussed in our decision, we remain convinced of the obviousness to the skilled artisan of modifying the admitted prior art with the contoured shape of the electrical connector of Gerrans for better gripping. In that regard, as discussed above, the modification taught by Gerrans is suggested by the reference itself as well as the inferences which the skilled artisan would draw therefrom.

We have granted Appellant's request to the extent that we have reconsidered our decision of May 31, 2005, but we deny the request with respect to making any changes therein.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REHEARING/DENIED


ERROL A. KRASS
Administrative Patent Judge

~~LANCE LEONARD BARRY~~
~~Administrative Patent Judge~~

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

MAHSHID D. SAADAT
MAHSHID D. SAADAT
Administrative Patent Judge

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